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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: **Bachmann**			
Serial No.:	09/033,901	Art Unit:	2173
Filed:	February 28, 1998	Examiner:	Luu, S.
For:	METHOD FOR SHOWING THE EXECUTION TRAIL OF OBJECTS IN A GRAPHICAL PROGRAMMING LANGUAGE	Docket No.:	050816-1010

REPLY BRIEF UNDER 37 C.F.R. §1.193

Assistant Commissioner for Patents
Box: AF (Reply Brief)
Washington, DC 20231

Sir:

This Reply Brief under 37 C.F.R. §1.193 is submitted in response to the Examiner's Answer mailed on November 30, 2000.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Agilent Technologies' Deposit Account No. 50-1078.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope, with sufficient postage, addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231,
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Signature: Sue A Hebert

REMARKS

This is a full and timely response to the Examiner's Answer of July 11, 2000. Upon entry of this Reply Brief, claims 1-9 remain pending in this application, and claims 3-9 remain appealed. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Response to §103 Rejections

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, "(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted).

Group I

Claim 3

Claim 3 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Wilson* in view of *Kurtenbach*. Claim 3 is dependent upon claim 1, and claims 1 and 3 presently read as follows:

> 1. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
>
> ***executing a plurality of the icons***;
>
> ***setting a flag for each icon executed in the executing step***, the flag corresponding with the each icon; and
>
> ***highlighting each icon corresponding with each flag set in the setting step***. (Emphasis added).

> 3. The method of claim 1, further comprising the steps of:
>
> ***receiving an input subsequent to the executing step***; and
>
> ***performing the highlighting step in response to the receiving step***. (Emphasis added).

Applicant asserts that the prior art combination of *Wilson* and *Kurtenbach* fails to disclose at least the combination of features highlighted hereinabove and that the prior art combination is, therefore, inadequate to reject claim 3 under 35 U.S.C. §103.

It is contended in the Examiner's Answer that the prior art teaches the highlighted features of claim 3 because:

> as shown in Wilson's figure 4, during the course of the execution of the icons in the flow chart and prior to the highlighting of icon 60, an input signal must be sent to the system to let the system know that a particular icon 60 is to be highlighted. Since the particular icon is to be highlighted in response to and during execution of the icon, it would have been obvious that the execution of the icon commences prior to the highlighting process. Thus, the highlighting process is performed only "subsequent to" or after the actual execution of the icon takes place.

Applicant respectfully asserts that the foregoing scenario described in the Examiner's Answer is insufficient for showing that the combination of features in claim 3 are suggested by the prior art of record. In this regard, the "input signal," according to pending claim 3, is received "subsequent" to the step of "executing a ***plurality of... icons***," and this same "plurality of icons" is then highlighted "in response" to reception of the "input signal." (Emphasis added). Thus, at least two icons are executed in the executing step, and ***each*** of these icons is then highlighted "in response" to the input signal that is received after the "executing" step.

Even the combination of *Wilson* and *Kurtenbach* shows that a "particular" icon is highlighted in response to "an input signal," as alleged in the Examiner's Answer, there is nothing in the prior art of record to suggest that a previously executed icon should be highlighted "in response" to the reception of this same "input signal." More specifically, the Patent Office appears to be alleging that while a particular icon is being executed, a signal is transmitted to indicate that the particular icon is executing and, therefore, should be highlighted. Thus, the particular icon is highlighted "in response" to this signal, which is transmitted and received subsequent to commencement of the execution of the icon. However, there is nothing to indicate that a previously executed icon is or should be highlighted "in response" to the foregoing signal.

To better illustrate the foregoing point, assume that two icons are highlighted according to the combination of *Wilson* and *Kurtenbach*. The first icon would execute, and during execution, this icon would be highlighted. After execution of the first icon, execution of the second icon would commence. As alleged in the Office Action, a signal may be generated to indicate that the second icon should be highlighted. In response, the second icon is highlighted. However, there is no suggestion in the prior art of record to highlight the first icon (or any other icon) in response to this signal. Therefore, the combination of *Wilson* and *Kurtenbach* fails to

suggest at least the feature of performing, in response to reception of an input signal, the step of highlighting "each" icon that is executed in the "executing" step described by claim 3.

For at least the foregoing reasons, Applicant asserts that the reasons set forth in the Examiner's Answer for maintaining the rejections to claim 3 are inadequate for establishing that the prior art of record shows or suggests each feature of pending claim 3. Thus, Applicant respectfully asserts that the Patent Office has failed to establish a *prima facie* case of obviousness, and the rejection to claim 3 should, therefore, be withdrawn.

Group II

Claim 4

Claim 4 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Wilson* in view of *Kurtenbach*. Claim 4 reads as follows:

> 4. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
>
> ***executing a plurality of the icons***;
>
> indicating which of the icons are executed in the executing step;
>
> ***determining, subsequent to the executing step and based on the indicating step, that the plurality of icons have been executed***; and
>
> ***highlighting the plurality of executed icons in response to the determining step***. (Emphasis added).

Applicant asserts that the combination of *Wilson* and *Kurtenbach* fails to disclose at least the features of claim 4 highlighted hereinabove and that the combination is, therefore, inadequate to reject claim 4 under 35 U.S.C. §103.

It is asserted in the Examiner's Answer that the "same reasoning which has been set forth hereinabove in the reply of claim 3 by the Examiner is applicable" to the arguments pertaining to the claims of Group II. However, as set forth hereinabove in the arguments for allowance of claim 3, the prior art of record fails to suggest highlighting a ***plurality*** of executed

icons in response to an "input signal." Thus, even if the Patent Office's characterization of the prior art set forth in the Examiner's Answer is accurate, Applicant submits that at least the combination of features highlighted hereinabove in claim 4 is not suggested by the prior art of record. As a result, the rejection to claim 4 is improper and should be withdrawn.

To better illustrate the foregoing point, assume that a plurality (*e.g.*, two) icons are executed according to the scenario described in the Examiner's Answer. The first icon would commence execution and, according to the Examiner's Answer, an "input signal" would be produced indicating that the first icon is executing and, therefore, should be highlighted. However, such a determination to highlight the first icon apparently occurs prior to execution of the second icon and, therefore, does not occur after ***both*** icons have been executed. More particularly, the first icon is not highlighted "in response" to a "determining" step that occurs after the ***plurality*** of icons have been executed.

After the first icon has been executed and highlighted, the second icon commences execution and is, therefore, highlighted. According to the Examiner's Answer, such highlighting occurs subsequent to execution of the second icon. Thus, according to the reasoning in the Examiner's Answer, such highlighting occurs subsequent the step of "executing (the) plurality of icons." However, as previously set forth, the highlighting of the first icon did not occur in response to a determination that occurred "subsequent to" this executing step. Accordingly, even if the Patent Office's characterization of the prior art is assumed to be true, the combination of features highlighted hereinabove in claim 4 is not suggested by the prior art of record. Thus, Applicant respectfully asserts that the Patent Office has failed to establish a *prima facie* case of obviousness regarding claim 4 and that the rejection to claim 4 should be withdrawn.

Claim 5

Claim 5 presently stands rejected in the Office Action under 35 U.S.C. §103 as purportedly being unpatentable over *Wilson* in view of *Kurtenbach*. Applicant submits that the pending dependent claim 5 contains all features of its respective independent claim 4. Since claim 4 should be allowed, as argued hereinabove, pending dependent claim 5 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 7

Claim 7 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Wilson* in view of *Kurtenbach*. However, similar to claim 4, pending claim 7 reads as follows:

> 7. An iconic programming computer system containing an existing network of connected icons, the system programmed to perform the following steps:
>
> executing a plurality of the icons;
>
> indicating which of the icons are executed in the executing step;
>
> ***determining, subsequent to the executing step and based on the indicating step, that the plurality of icons have been executed***; and
>
> ***highlighting the plurality of executed icons in response to the determining step***. (Emphasis added).

For at least the same reasons set forth hereinabove in the arguments for allowance of claim 4, Applicant respectfully asserts that the Patent Office has failed to set forth a *prima facie* case of obviousness regarding claim 7 and that the rejection to claim 7, therefore, should be withdrawn.

Claim 8

Claim 8 presently stands rejected in the Office Action under 35 U.S.C. §103 as purportedly being unpatentable over *Wilson* in view of *Kurtenbach*. Applicant submits that the

pending dependent claim 8 contains all features of its respective independent claim 7. Since claim 7 should be allowed, as argued hereinabove, pending dependent claim 8 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Group III

Claims 6 and 9

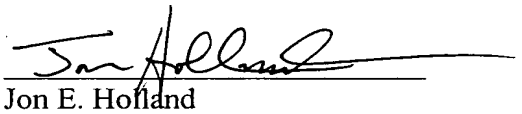
Claims 6 and 9 presently stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Wilson* in view of *Kurtenbach*. However, both claims 6 and 9 include the "executing," "determining," and "highlighting" steps described by claims 4 and 7, and claims 6 and 9, similar to claim 3, also include the features of "receiving an input subsequent to the executing step" and "performing the determining step in response to the receiving step." Thus, for the reasons set forth hereinabove in the arguments for allowance of the claims in Groups I and II, Applicant submits that the the rejections to claims 6 and 9 are improper and should be withdrawn.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this paper, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.

By: 

Jon E. Holland
Reg. No. 41,077

100 Galleria Parkway, N.W.
Suite 1750
Atlanta, Georgia 30339
(770) 933-9500